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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,627	11/26/2003	Aaron Smith	5490-000354	7114

27572 7590 10/31/2006

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EXAMINER
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SWIGER III, JAMES L

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/722,627

Applicant(s)

SMITH, AARON

Examiner

James L. Swiger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 3,4 and 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/26/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, Species E (claims 1-2 and 5-22) in the reply filed on 7/25/2006 is acknowledged. The traversal is on the ground(s) that the fields of search would be similar. This is not found persuasive because the features are disclosed as alternative embodiments and may be separately patentable.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3-4 and 23-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species and invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/25/2006.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

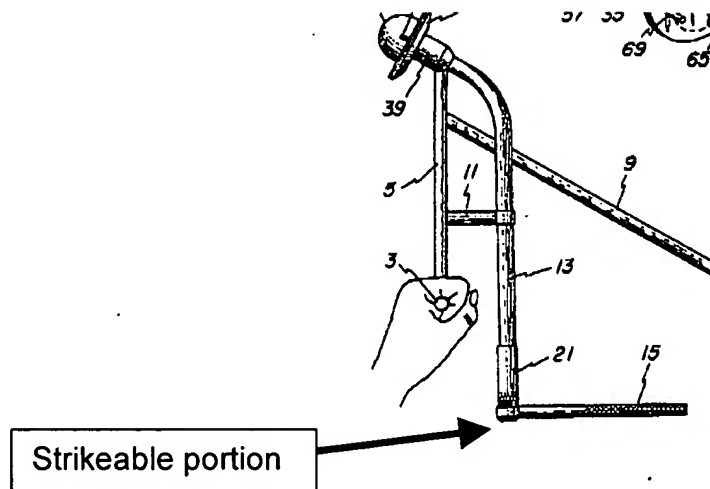
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rehmann et al. (US Patent 5,540,697). Rehmann et al. discloses an installation apparatus having a prosthetic engaging portion (28 and 68), a graspable portion (36), a torque transfer system (22) that extends in a plane away from the body of the installation device defining a second plane as well with respect to the device, and also wherein the torque transfer system to at least engage and disengage a prosthetic via a

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torque transfer system (see Fig. 2). Rehmann et al. also disclose what is considered a strikeable portion (70) that extends from a graspable portion, an acetabular cup portion (20), an intermediate portion (86) generally parallel to the first plane and considered at least partially spaced from a plane, and an extending member (40) that connects to at least the graspable portion, and has a prosthetic engaging portion disposed distally from the graspable portion. The prosthetic engaging portion being positioned through an incision is considered a functional limitation. Also part of the torque transfer system in Fig. 2 is considered at the distal end, and also at least a portion (such as 40) is at a distance from the graspable portion.

Claims 13-18 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Bertuch, Jr. (US Patent 4,305,394). Bertuch, Jr. discloses a positioning instrument having a graspable portion (21) able to transfer force over a first line (considered along the elongate section 13), an intermediate portion (13), item (11) may be considered the spaced section of the intermediate portion, an angled portion (the angled, bent portion in Fig. 3 above 13), a torque transfer system (97), and also wherein the torque transfer system can operate to engage or release said implant (Col. 1, lines 58-68). The end portion (shown below) is considered a strikeable portion.



Bertuch, Jr. also disclose a portion that is a parallel member (5) as part of the intermediate portion, and is substantially parallel with the first line formed by the elongate portion (13), and discloses a tool to engage the bone transfer system (15). Also, the torque transfer system is operable to transfer torque about an angle (in the curved portion (see Fig. 12 and 97) and is capable of providing a clear view from this vantage point. The flexible member of the torque transfer system is the cable, and is operable by a provided tool (137), and also the torque transfer system may be considered substantially adjacent at least where the two portions meet at the distal end. Again, insertion through the dermas is considered a functional limitation.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rehmann et al. in view of Rohr (US Patent 5,431,657). Rehmann et al. disclose the claimed invention except for a prosthetic engaging portion having threads. Rohr disclose threads (22) for engaging the prosthetic portion to aid in engaging the prosthetic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Rehmann et al. having at least threads for prosthetic engagement in view of Rohr to better insert the device. (Col. 2, lines 50-69 through col. 3, lines 1-11).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bertuch, Jr. in view of Rohr. '657. Bertuch, Jr. disclose the claimed invention except for the torque transfer having threads to engage the implant. Rohr disclose threads (22) for engaging the prosthetic portion to aid in engaging the prosthetic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bertuch, Jr. having at least threads for prosthetic engagement in view of Rohr to better insert the device. (Col. 2, lines 50-69 through col. 3, lines 1-11).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rehman et al. on view of Roche (US patent 4,632,111). Rehman et al. disclose the claimed invention except for the torquing instrument being near a distal end. Roche disclose what is considered a torquing instrument (18--position via torque) directly at a distal end (see fig. 1 and Col. 4, lines 32-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of

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Bertuch, Jr. having at least a torque device at the distal end in view of Roche to better orient the prosthetic in use.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bertuch, Jr. '394 in view of Rohr. '657. Bertuch, Jr. disclose the claimed invention except for a prosthetic engaging portion having threads. Rohr disclose threads (22) for engaging the prosthetic portion to aid in engaging the prosthetic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bertuch, Jr. having at least threads for prosthetic engagement in view of Rohr to better insert the device. (Col. 2, lines 50-69 through col. 3, lines 1-11).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

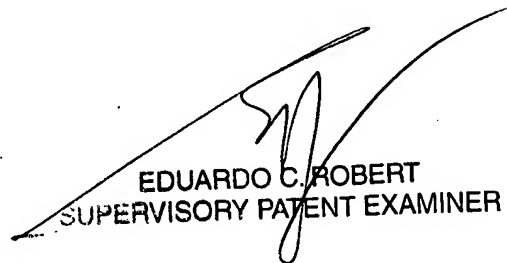
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLS



10/24/06



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